

IN THE DRAWINGS:

By separate submission, corrected drawings are submitted responsive to the points raised by the Examiner in the prior Office Action and the current Office Action. In the current action, the Examiner objected to Figure 1 since two "6ds" were present. Corrected Figure 1 removes the offending "6d" and the current objection is overcome. Therefore, the drawings are suitable for entry.

**REMARKS**

By this amendment, corrected drawings are submitted in a separate submission, and claims 1, 5, 8, and 11 have been amended to place this application in condition for allowance. Currently, claims 1-12 are before the examiner for consideration on their merits.

The various issues raised in the Office Action are addressed below by their respective headings.

**SPECIFICATION:**

Applicant again requests entry of the substitute specification filed with the previous response on the grounds that the new matter rejection is improper. In the Office Action, the Examiner alleged that the substitute specification added new matter. Applicants respectfully contend that the Examiner's position is in error.

The issue of new matter revolves around whether Applicant can amend the specification and claims to recite that the elastic member is midway between the proximal and distal end portions of the batt structure. The Examiner contends that there is inadequate support to make this amendment.

To the contrary, corrected Figures 2 and 6 alone show the elastic member 10 in a position that is midway between the distal end portion 6d and the proximal end portion 6c. Applicants are entitled to rely on the drawings as originally filed to support changes to the claims and specification. Reciting this language in the specification does not introduce new matter, and the objection to the request for entry of the substitute specification should be withdrawn.

The Examiner also objected to the change of "free end" to "distal end" on page 24 of the specification. This change is made since the term "distal end region" is used to refer to the same structure earlier in the paragraph. The change in question is not a new matter issue, it merely makes the paragraph consistent in using the same terminology to describe the "distal" end of the batt structure. This change does not even raise a question of new matter, and cannot preclude entry of the substitute specification.

The objection to the claims is also considered moot since claims 1 and 5 have been revised to state that the elastic member is aside the distal end portion and toward the proximal end portion. This language is clearly supported by Figures 2 and 6, and an issue of new matter is not raised by this amendment.

#### DRAWINGS

The problem with the drawings is addressed above in conjunction with submission of corrected Figure 6.

#### CLAIMS

Claims 1, 8, and 11 have been amended in response to the notation made in paragraph 7 of the Office Action. Accordingly, this objection should be withdrawn.

#### PRIOR ART REJECTION

In the prior art rejection, the Examiner rejects claims 1-4 and 8-12 under 35 USC §103(a) based on WO 99/63921 to Chmielewski et al. (Paragon) when taken in view of United States Patent No. 5,897,544 to Ronnberg and newly-applied United States Patent

No. 5,558,660 to Dreier. Claims 5-7 are rejected under 35 U.S.C. § 103(a) using the same references and further relying on the Onishi et al. patent.

Basic to each rejection is the allegation that Paragon teaches all of the claim limitations except for the elastic member as defined in claims 1, 5, and 11. In Paragon, the Examiner notes that elastic member 718 is employed to create the space 802. In response to this deficiency, the Examiner cites Ronnberg to allege that it is known to use lateral elastic members 36 or 37 to form an opening, see col. 5, line 35 et seq. The Examiner also relies on Dreier for the teaching of using an elastic member, and specifically points to elastic member 154 as shown in Figure 14. The Examiner concludes that it would be obvious to modify Paragon and employ the lateral elastic members of Ronnberg and Dreier, since each of the elastic members of Ronnberg and Paragon functions in the same way.

In response to the claim amendment that the elastic member is located midway between the distal and proximal end portions of the supplementary batt structure, the Examiner argues the following:

- 1) The position of the Ronnberg elastic meets this claim limitation.
- 2) Even if the prior art does not teach placing the elastic as claimed, such a placement would be *prima facie* case of obviousness without some evidence showing criticality to the placement.

First and as noted above, claims 1 and 5 are amended to define the elastic member as being aside the distal end portion and toward the proximal end portion. As argued above, this amendment is clearly supported by the application as originally filed.

Applicants also traverse the rejection of the claims. In essence, the issue in this

case is whether:

(a) Ronnberg or Dreier teaches the claimed placement of the elastic member such that its use in Paragon would result in a structure reading on independent claims 1, 5 or 11; or

(b) Assuming that Ronnberg and Dreier do not teach an elastic structure that is aside the distal end of the supplemental batt structure, whether it would be obvious to move the elastic member so that is would be aside the distal end and toward the proximal end portion as defined in claims 1 and 11, and between the two batt structures as defined in claim 9-11.

On issue (a), it is strenuously asserted that Ronnberg or Dreier do not teach a position of the elastic member anywhere but at the distal end of the supplemental batt structure. In the Office Action, the Examiner appears to use the absorbent layer 12 of Ronnberg as a reference structure for determining that the elastic member is somehow positioned at the claimed midway point. While claims 1 and 5 do not use the "midway" language, this position is incorrect anyway since the distal and proximal end portions recited in the claims refer to the supplemental batt structure, which would be absorbent layer 14 of Ronnberg. The only fair reading of Ronnberg is that the elastic 34 is at the distal end of the absorbent layer 14. It cannot be said that the elastic is somehow midway between the ends of the layer 14, that it is aside from the distal end, or between the two batt structures; it is at the distal end.

Dreier is cumulative to the teachings of Ronnberg in this respect and cannot be said to teach an elastic member that meets the claim limitations of claims 1, 5, or 11. Therefore, issue (a) can only be properly resolved by concluding that Ronnberg and

Dreier does not teach the claimed placement of the elastic member, and even if these references were combined with Paragon, the disposable diaper of claims 1, 5, and 11 would still not be taught.

This leaves issue (b) for resolution. Applicant contends that resolution of this issue falls in Applicants' favor for two reasons. First, there is no motivation or reasoning to support the Examiner's conclusion that it would be *prima facie* case of obviousness to put the elastic member anywhere. Second, there are distinct advantages to the placement of the elastic member as discovered by the inventors, and these advantages weigh in favor of the patentability of claims 1, 5, and 11 and against the allegation of obviousness.

Turning to the first reason, nowhere does Ronnberg or Dreier suggest placing the elastic member anywhere but on the distal end of the supplemental batt structure. In fact, Ronnberg has specific structure in the form of barrier means extending away from the distal end of the layer 14. Similarly, Dreier has specific structure at the end of the pocket 50. It is respectfully contended that neither of these references provide any hint of a suggestion to support the Examiner's speculation that it would be obvious to move the elastic member from the distal end of the layer 14 of Ronnberg or the pocket 50 of Dreier, and position it aside the distal end portion and towards the proximal end portion or place it between the two batt structures, and any rejection of this nature is wholly improper.

At best, the Examiner is engaging in the hindsight reconstruction of the prior art in light of Applicants' disclosure, and such a stance cannot support a rejection under 35 U.S.C. § 103(a). As the Examiner knows, the burden of establishing a *prima facie* case of obviousness is placed on the Examiner, and this burden must be supported by facts; it

cannot be made based on mere conjecture of speculation.

Furthermore, the prior art designs are all problematic in that the elastic member is positioned at the opening of the pocket that is formed by the supplemental batt structure and the basic absorbent layer of the diaper. The presence of the elastic member at the opening can impede or interfere with the flow of feces into the opening. With the inventive arrangement, the pocket opening is maintained, but there is no interference with material entering the pocket, and the diaper functions more effectively. This improvement is nowhere to be found within the four corners of either Ronnberg or Dreier, and this effectively weighs in favor of the patentability of claims 1 and 5.

Based on the amendments and arguments above, each of independent claims 1, 5, 9-11 are patentable over the applied prior art.

#### DOUBLE PATENTING

Applicants disagree with the Examiner's contention that the claims are obvious variants of the co-pending application. In the rejection, the Examiner asserts that Applicants are merely adding an elastic member to the disclosure of the co-pending application. To the contrary, the invention is not the mere addition of an elastic member to the disclosure of the co-pending application. Rather, and as argued above, Applicants assert that the claimed invention stands on its own for patentability, including being patentably distinguishable over the teachings of Ronnberg and Dreier. Since claims 1, 5, and 11 are patentably distinct from the combination of Paragon, Ronnberg and Dreier, they cannot be rejected based on obviousness-type double patenting and Ronnberg/Dreier, and this rejection must be withdrawn.

SUMMARY

By the amendments and arguments made above, each and every issue raised in the outstanding Office Action has been resolved. The changes to the drawing and specification remove all of the objections. Further, the Examiner has failed to establish a *prima facie* case of obviousness against claims 1 and 5, and new claims 9-12.

Therefore, the Examiner is respectfully requested to examine this application in light of this amendment, and pass claims 1-12 onto issuance.

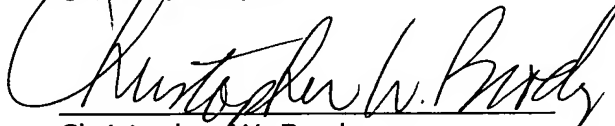
If the Examiner believes that an interview with Applicants' attorney would be helpful in expediting prosecution of this application, the Examiner is invited to telephone the undersigned at the number set forth below.

The above constitutes a complete response to all issues raised in the Office Action of January 19, 2005.

Again, reconsideration and allowance of this application is respectfully requested.

Please also charge any fee deficiencies or credit any overcharges to deposit account no. 50-1088.

Respectfully submitted,  
CLARK & BRODY

A handwritten signature in black ink, appearing to read "Christopher W. Brody", written over a horizontal line.

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